

REMARKS

Claims 1, 3–6, 9–11, 13, 14, 16–19, 21–30 are pending in the present application.

Claims 1, 3–6, 9–11, 13, 14, 16–19 are rejected. Claims 21–26 were withdrawn from consideration.

Claims 1, 3, 5, 11, 13 and 17 were amended solely to correct typographical errors therein.

Claims 27–30 were added.

Reconsideration of the claims is respectfully requested.

Request for Reconsideration of Restriction Requirement

In passing on questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01. A proper restriction requirement must be based on a showing that (a) the patent contains claims directed to two or more inventions which are independent or distinct, and (b) the restriction requirement is necessitated by a serious burden on the examiner in examining all of the inventions claimed. MPEP § 803. The Examiner must provide reasons and/or examples to support the restriction requirement. MPEP §§ 803, 808.

Restriction is only proper where the claims are independent or distinct. MPEP § 806. Independent inventions are those not connected in design, operation, or effect. MPEP § 808.01. Distinct invention may be, for example, combination and subcombination claims (in which case

two way distinctness must be shown), a process and apparatus for its practice, a process of making and the product made, an apparatus and a product made, or a product and process of using. MPEP §§ 806.05(c), 806.05(e), 806.05(f), 806.05(g), 806.05(h). However, where the claims define the same essential characteristics of a single disclosed embodiment of an invention, restriction is not proper. MPEP § 806.03.

For the purposes of an initial restriction requirement, a *prima facie* showing of a serious burden on the examiner is shown by explanation of separate classification, separate status in the art, or different fields of search. MPEP §§ 803, 808.02, 816.

In the present invention, no reasons are provided for either element-independent or distinct inventions or serious burden--necessary for a proper restriction requirement. A *prima facie* case for restriction has therefore not been properly made with respect to the claims as pending.

In addition, independent claim 17 is generic to the limitations of pending independent claims 1 and 21.

35 U.S.C. § 112, Second Paragraph (Definiteness)

Claims 1, 5–6 and 11 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. This rejection is respectfully traversed.

Claims 1, 5 and 11 were amended to correct the errors identified in the Office Action.

Therefore, the rejection of claims 1, 5–6 and 11 under 35 U.S.C. § 112, second paragraph has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 1, 3–4, 8–11, 13–14 and 16–19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application Publication No. 09237870 (“JP ‘870”) in view of European Patent Application Publication No. 0181600 (“EP ‘600”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d

1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As conceded in the Office Action, neither reference discloses vertically stacking three conductors to attenuate parasitic capacitance as recited in the claims. Neither reference provides any basis for a reasonable expectation of success in modifying the respective teachings to achieve the claimed invention. In particular, EP '600 depicts a stray capacitance between the transmission line TL and the underlying substrate 14; neither reference suggests that the effects of such capacitive coupling may be negated by insertion of an intervening auxiliary line AL.

ATTORNEY DOCKET No. 98-C-037C2 (STMI01-98037)
U.S. SERIAL NO. 09/757,378
PATENT

Therefore, the rejection of claims 1, 3–4, 8–11, 13–14 and 16–19 under 35 U.S.C. § 103 has been overcome.

ATTORNEY DOCKET NO. 98-C-037C2 (STMI01-98037)
U.S. SERIAL NO. 09/757,378
PATENT

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at dvenglarik@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 7-9-03


Daniel E. Venglarik
Daniel E. Venglarik
Registration No. 39,409

P.O. Box 802432
Dallas, Texas 75380
(972) 628-3621 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: dvenglarik@davismunck.com